



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/556,729	11/14/2005	Hiroyuki Kikkoji	277537US6PCT	3279
22850	7590	12/30/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER	
			SU, EMILE	
			ART UNIT	PAPER NUMBER
			3685	
			NOTIFICATION DATE	DELIVERY MODE
			12/30/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/556,729	<b>Applicant(s)</b> KIKKOJI ET AL.	
	<b>Examiner</b> EMILE SU	<b>Art Unit</b> 3685	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/2/2009 and 12/7/2009</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgements***

1. This Office Action is in response to communications filed on October 16, 2009. Claims 1, 4, 5, 8, and 11 are amended. Claims 9-10 are withdrawn. Claim 15 is newly presented.
2. Claims 1-8 and 11-15 are currently pending and are rejected.

### ***Priority***

3. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d), a certified English translation of the foreign application is required. MPEP §201.14.

### ***Response to Arguments***

4. Applicant's arguments filed October 16, 2009 have been fully considered but they are not persuasive.

Applicant is of the first opinion that Claim 1 satisfy U.S.C. §101 requirements (Applicant Remarks, p. 10). Examiner respectfully disagrees. Specifically, Applicant relies on Fig. 1 to find support of an apparatus machine. However, Fig. 1 represents block diagrams using “means” language, and does not necessarily incorporate specific structure. Further, Applicant has pointed out that examiners are to “[give] claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art’” in the remarks. The specification does not explicitly point out what constitutes a receiver and does not further elaborate on the concept of

Art Unit: 3685

“unit”. One of ordinary skill in the art would then consult with a IEEE dictionary for electronic terms to interpret Applicant’s invention as IEEE is one of the world’s leading standards-making organization. Therefore, a supposedly broad interpretation of Applicant’s invention encompasses software only means in the claimed apparatus. To further clarify structure of the Apparatus, more specific recitation of structure components is needed, for example, “a receiver antenna” and “a computer memory”. The rejection under U.S.C. §101 is maintained.

Applicant is of the second opinion that Claims 5-8 and 13 satisfy U.S.C. §101 requirements (Applicant Remarks, p. 11). Examiner respectfully disagrees. Specifically, Applicant states that broadcasting station, receiver, memory unit, and memory constitute structure. As noted in the previous Office Action, these terms do not necessarily require hardware. Therefore, Claim 5 does not satisfy the requirement of a tie to another statutory class. Applicant is reminded that a tie to another statutory class is to disclose a special purpose machine for performing the recited method. By way of example, a sufficient tie can be recited as “calculating, by a computer processor, a sequence of data.” The rejection under U.S.C. §101 is maintained.

Applicant is of the third opinion Claims 2 and 6 do not introduce new matter (Applicant Remarks, p. 11). Examiner respectfully disagrees. Specifically, Applicant relies on “a predetermined clock time” found on page 10, line 26 - page 11, line 12 of the specification. However, the clock time is only a single instant of time, as suppose to the claim limitation that recites a “time interval” (i.e. a period of time). The rejection under U.S.C. §112 first paragraph is maintained.

Applicant is of the fourth opinion that Claims 3 and 7 do not introduce new matter (Applicant Remarks, p. 11). Examiner respectfully disagrees. Specifically, Applicant relies on “for a predetermined time period” found on page 10, line 26 – page 11, line 12 of the specification. However, the predetermined time period is a fixed time period (e.g. a predetermined time period of 5 minutes). The recited passage does not give support to “*different* amounts of first contents” as claimed in the limitations. The rejection under U.S.C. §112 first paragraph is maintained.

Applicant is of the fifth opinion that amendments to Claims 4 and 8 have overcome U.S.C. §112 second paragraph requirements (Applicant Remarks, p. 12). Examiner respectfully disagrees. Specifically, the rejection was made as the correlation of “first contents” and “first contents-related information” has not been previously disclosed. The only relevant disclosure is “to store and relate” in Claims 1 and 8. However, relating differs from correlating as the latter further requires one of two elements to imply or complement the other. Therefore, there is insufficient antecedent basis for the limitation in Claims 4 and 8, and the rejection under U.S.C. §112 second paragraph is maintained.

Applicant is of the sixth opinion that prior art of Poltorak discloses limitations in separate apparatus (Applicant Remarks, p. 13). Examiner respectfully disagrees. Specifically, Poltorak discloses a single apparatus having three subsystems within (see Poltorak, col. 11 lines 45-55). Therefore the cited prior art continues to read on the claimed limitations.

Art Unit: 3685

5. The following assertion(s) of facts have gone unchallenged and are therefore considered admitted prior art:

- Different amounts of content can be stored in a memory

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 1-8 and 12-13** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Concerning Claim 1**, Applicant recites “receiver”, “memory unit” and “memory” in the limitations. These terms are known to be only software components (see IEEE, “The Authoritative Dictionary of IEEE Standards Terms”, seventh edition, pp. 204, 684, 934, 1112, 1234, and 1235). Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. *See In re Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized. Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical “things”. They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any

Art Unit: 3685

structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. See *In re Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035. The subject matter of Claim 1, as claimed, is descriptive material per se and hence nonstatutory.

**As to Claims 2-4 and 12**, see discussion of Claim 1 above. These depending claims inherit and repeat the same U.S.C. §101 deficiency as Claim 1 and are rejected in the like manner above.

**Concerning Claim 5**, Applicant's method claim is non-statutory for failing the machine-or-transformation test. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, in order for a method to be considered a "process" under 35 U.S.C. §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or

Art Unit: 3685

to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, Claim 5 fails prong (1) because there is no specific tie to machine or structure for performing the steps. Additionally, the claim fails prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

**As to Claims 6-8 and 13**, see discussion of Claim 5 above. These depending claims inherit and repeat the same U.S.C. §101 deficiency as Claim 5 and are rejected in the like manner above.

***Claim Rejections - 35 USC § 112, First Paragraph***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. **Claims 2, 3, 6, and 7** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.



**Concerning Claims 2 and 6**, Applicant amended the claims to recite “at specific time intervals in a buffer”. There is no support found in the disclosure to convey Applicant had possession of altering time intervals of a buffer.

**Concerning Claims 3 and 7**, Applicant amended the claims to recite “recording different amount of first contents in the buffer”. The most relevant disclosure is found on Pages 9 and 12 of the original Specification. However, there is no support for recording different amount of content as the disclosure only describes storing different time periods. There is insufficient support to convey Applicant had possession of changing the amount of content stored in a buffer.

***Claim Rejections - 35 USC § 112, Second Paragraph***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. **Claims 1-4 and 8** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Regarding Claim 1**, Applicant’s recitation of the invention includes language for both an apparatus and a process in a single claim. Specifically, Applicant claims a “memory” while also claiming a process of using the system “store and relate when the input recording request is entered externally” in the limitations. In this case, Applicant is setting the timing condition on how to use the memory by reciting “when”. Also, Applicant claims a “temporary memory unit” while also claiming a process of using the

Art Unit: 3685

system “temporarily stored” in the limitation. In this case, Applicant is describes a specific storing step that has to be temporary. A single claim which purports to be both a product or machine and a process is ambiguous and is rejected for failing to particularly point out and distinctly claim the invention. See *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990). **Further**, Applicant amended to recite “temporarily stored in the temporary memory unit” in the limitations. However, it is unclear how short a duration (or how long) is considered to be temporary. The term “temporarily” is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

**Regarding Claims 4 and 8**, Applicant recites “the first contents-related information received from the server” and the limitations are unclear. Claim1, from which Claim 4 depends, is silent as to the correlation of “first contents” and “first contents related information” in regard to the server. Claim 1 merely recites “relate ... the first contents and the first contents-related information” and does not establishing any correlation where one element implies or complements the other element. There is insufficient antecedent basis for this limitation in the claims.

**As to Claims 2 and 3**, see discussion of Claim 1 above. These depending claims inherit the same U.S.C. §112 second paragraph deficiency as Claim 1 and are rejected in the like manner above.

Art Unit: 3685

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. **Claims 1, 5, 12, 13, and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Poltorak, U.S. Patent No. 7,164,882 B2 (hereinafter Poltorak) in view of Kunkel et al., U.S. Patent No. 5,961,603 (hereinafter Kunkel) and Levy et al., U.S. Patent No. 6,505,160 B1 (hereinafter Levy).

**With respect to Claims 1, 5, 12, 13, and 15, Poltorak discloses:**

a receiver configured to receive first contents (see Poltorak, Abstract; also see Column 16, Lines 52-61 and Column 20, Lines 16-32) from a broadcasting station (see Poltorak, Column 2, Line 62 through Column 3, Line 3) and to receive an input purchase request (see Poltorak, Column 14, Lines 3-9; also see Column 17, Line 57 through Column 18, Line 9);

a memory, in the content receiving apparatus (see Poltorak, Column 12, Line 58 through Column 13, Line 2), configured to store (see Poltorak, Column 13, Lines 22-24) and to relate, the first contents and the first contents-related information (see Poltorak, Column 13, Lines 3-21).

However, Poltorak does not specifically disclose a separate temporary memory unit configured to temporarily store first contents-related information related to the first contents. Kunkel does teach a separate temporary memory unit configured to temporarily store contents-related information related to the contents (see Kunkel, Column 4, Line 59 through Column 5, Line 6; also see Column 6, Lines 33-56, Column 7, Lines 26-39, and Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to store related information in a cache as taught by Kunkel, because this allows user to quickly access information without waiting for transmission time (see Kunkel, Column 4, Line 59 through Column 5, Line 6).

Poltorak does not specifically disclose input recording request. However, Poltorak does teach the use of input device to input a purchase request (see Poltorak, Column 14, Lines 3-9; also see Column 17, Line 57 through Column 18, Line 9) and Levy does teach

Art Unit: 3685

a user activated recording request (see Levy, Column 14, Lines 43-58; also see Column 14, Line 34 through Column 15, Line 13). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Poltorak in view of Levy to create a recording apparatus that records and relates contents-related and broadcast information in response to an input, because the manual input of recording request increases user control over the recorded content.

Poltorak does not explicitly disclose storing a plurality of second contents and a plurality of second contents-related information, the second contents-related information being related to the first contents. Poltorak, however, does suggest plurality of MP3 transmissions (see Poltorak, Column 16, Lines 26-38) and purchase of an album (see Poltorak, Column 11, Lines 17-27; also see Column 15, Lines 52-62, Column 17, Line 57 through Column 18, Line 54). Poltorak also teaches contents-related information such as album information (see Poltorak, Column 13, Lines 3-22). A predictable result would have been to record any second content, such as songs from a single album, along with album information of the songs (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)). In this case, the songs are related as being from a single album. One of ordinary skill in the art would be motivated to do so because an album provides similar taste of music a user would enjoy.

Further, it has been held that manner or method in which machine is to be utilized is not germane to issue of patentability of machine itself (*In re Casey*, 152 USPQ 235 (CCPA 1967); MPEP 2106 II C). The limitations following “configured to ...” do not warrant patentable weight for the purpose of prior art examination.

Further, it has been held while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). The limitations “to store and to relate when the input recording request is entered externally, the first contents and the first contents-related information” in Claim 1 do not warrant patentable weight for the purpose of prior art examination.

Further, it has been held that stored data is not functionally related to the memory in which it is stored it does not distinguish the claimed apparatus, method, and system from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01). The limitations “storing ... a plurality of second contents and a plurality of second contents-related information received from a server, the second contents-related information being related to the first contents” does not warrant patentable weight for the purpose of prior art examination.

16. **Claims 2, 3, 6, and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Poltorak, Levy, and Kunkel as applied to claims 1 and 5 above, and further in view of Fiedler, U.S. Patent No. 6,205,419 B1 (hereinafter Fiedler).

**As to Claims 2 and 6**, Poltorak, Levy, and Kunkel disclose the invention substantially as claimed. Poltorak further discloses:

a broadcast information recording unit configured to record the first contents and to record the first contents before and after the input recording request (see Poltorak,

Art Unit: 3685

Column 12, Line 58 through Column 13, Line 2; also see Column 13, Lines 22-24).

Poltorak and Levy do not specifically teach one to use circular buffer design to store information. Fiedler does discuss the use of circular buffer to record audio information before and after a request to record (see Fiedler, Column 3, Lines 31-48). It would have been obvious to one of ordinary skill in the art at the time of the invention to use circular buffer suggested by Fiedler in the recording apparatus of Poltorak to record information before and after a recording request, because circular buffer allows for more efficient operation by calculating only the necessary memory blocks.

Further, it has been held that manner or method in which machine is to be utilized is not germane to issue of patentability of machine itself (*In re Casey*, 152 USPQ 235 (CCPA 1967); MPEP 2106 II C). The limitations following “configured to ...” do not warrant patentable weight for the purpose of prior art examination.

**As to Claims 3 and 7**, Poltorak, Levy, Kunkel, and Fiedler disclose the invention substantially as claimed. Poltorak does not specifically teach one to use different buffer size. Official Notice is taken that storing different amounts of content in a memory is old and well known in the art (e.g. mixing a personal cassette tape). It would have been obvious to one of ordinary skill in the art at the time of the invention to recording different amount of content in a buffer, because this efficiently utilizes the buffer size.

Further, it has been held that manner or method in which machine is to be utilized is not germane to issue of patentability of machine itself (*In re Casey*, 152 USPQ 235 (CCPA 1967); MPEP 2106 II C). The limitations “to include recording different amounts

Art Unit: 3685

of first contents in the buffer” are not given patentable weight for the purpose of prior art examination.

17. **Claims 4 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Poltorak, Levy, and Kunkel as applied to claims 1 and 5 above, and further in view of Kim et al., U.S. Patent No. 6,912,431 B2 (hereinafter Kim).

**As to Claims 4 and 8**, Poltorak, Levy, and Kunkel disclose the invention substantially as claimed. Poltorak further discloses the contents are correlated with the contents-related information (see Poltorak, Column 17, Line 58 through Column 18, Line 9). Poltorak does not specifically disclose a sound information synthesizing unit configured to synthesize sound information with the contents being received at a time when the recording request is input. Kim does teach a sound information synthesizing unit configured to synthesize sound information with the contents being received (see Kim, Column 3, Lines 25-50) at a time when the recording request is input (see Column 6, Lines 6-16). It would have been obvious to one of ordinary skill in the art at the time of the invention to add a sound output taught by Kim to a recording apparatus disclosed by Poltorak to notify the current state of the apparatus, because this provides audio feedback about the current operation.

Further, it has been held that manner or method in which machine is to be utilized is not germane to issue of patentability of machine itself (*In re Casey*, 152 USPQ 235 (CCPA 1967); MPEP 2106 II C). The limitations following “configured to ...” are not given patentable weight for the purpose of prior art examination.



Further, it has been held while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). The limitation “when the recording request is input...” is also not given patentable weight.

18. **Claims 11 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Poltorak, Levy, and Kunkel as applied to claims 1 and 5 above, and further in view of Danneels et al. (U.S. Patent No. 6,272,472; hereinafter Danneels).

**With respect to Claims 11 and 14**, Poltorak and Levy disclose the invention substantially as claimed. See the discussion of Claims 1 and 5 above. Poltorak and Levy do not explicitly teach providing all the executable instructions on a computer-readable medium. Danneels teaches a computer-implemented method realized as one or more programs on a computer (see Danneels, Column 2, Lines 40-46). In addition, Danneels teaches that the programs are storable on a computer-readable medium such as a floppy disk or a CD-ROM (see Danneels, Column 2, Lines 46-49). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Poltorak in view of Levy discussed in Claims 1 and 5. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of distribution and installation and execution of the software on another computer (see Danneels, Column 2, Lines 46-49).

***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ellis et al., U.S. Patent No. 7,343,141 B2. Prior art discloses concurrent broadcast recording.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMILE SU whose telephone number is (571) 270-7040. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

Art Unit: 3685

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CALVIN L. HEWITT can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/EMILE SU/  
Examiner, Art Unit 3685  
December 19, 2009

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685